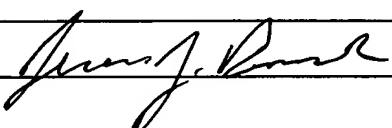







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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) <b>IVOO-0145</b>						
EXPRESS MAIL LABEL NO.: EV670672588US DATE OF DEPOSIT: December 27, 2005		Application Number 09/707,273	Filed November 6, 2000					
Signature   Typed or printed name <u>Jeremiah J. Baunach</u>		First Named Inventor Charles Eric Hunter, Bernard L. Ballou, Jr., Kelly C. Sparks, and John H. Hebrank						
		Art Unit 3661	Examiner Cuong H. Nguyen					
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"><tr><td><input type="checkbox"/> applicant/inventor.</td><td rowspan="4"> Signature <u>Jeremiah J. Baunach</u> Typed or printed name</td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. Registration number 44,527.</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td></tr></table> <p>206-332-1392 Telephone number <u>12/27/2005</u> Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>				<input type="checkbox"/> applicant/inventor.	 Signature <u>Jeremiah J. Baunach</u> Typed or printed name	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<input checked="" type="checkbox"/> attorney or agent of record. Registration number 44,527.	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____
<input type="checkbox"/> applicant/inventor.	 Signature <u>Jeremiah J. Baunach</u> Typed or printed name							
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)								
<input checked="" type="checkbox"/> attorney or agent of record. Registration number 44,527.								
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____								

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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### **PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated on the attached sheets. No more than five pages are provided.

### **REMARKS – REASON FOR REVIEW**

Claims 40-72 are pending in this present application, with claims 40, 64, and 69 being the independent claims. Claims 40-42, 48, 52-54, 60, 62, and 64-71 are rejected under 35 U.S.C. § 102(b) as being anticipated by Schulhof et al. (U.S. 5,572,442). Claims 43, 55, 44, and 56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schulhof et al. (U.S. 5,572,442), in view of McMillet et al. (U.S. 5,483,535).

Review of the outstanding rejections to the claims is respectfully requested in view of the following remarks and amendments.

#### ***Rejections under 35 USC § 102(b)***

Claims 40-42, 48, 52-54, 60, 62, and 64-71 are rejected under 35 U.S.C. § 102(b) as being anticipated by Schulhof et al. (U.S. 5,572,442).

Applicants submit Schulhof et al. does not disclose the subject matter of the claims. The Office Action describes how in Schulhof et al. orders for music selections are communicated and then transferred to the consumer for recording at the consumer site. However, the Office Action is silent on how and when the consumer is charged or billed for these orders. In fact, Schulhof et al. teaches or suggests that the consumer is charged at the time of ordering, as opposed to “upon the consumer recording the music selection on a storage medium located at a consumer site,” according to claim 40.

Furthermore, it is stated in Schulhof in column 7, lines 61-63 that “when the subscriber has completed placing the order, a payment icon is displayed that requires the subscriber to authorize billing to his account.” This is opposed to charging the consumer “upon the consumer recording the music selection on a storage medium located at a consumer site,” as appears in claim 40. Also, in Schulhof the “program includes a header that ...identifies the use allocation of the material,” and “actual use may be assigned as a function of the amount paid by the subscriber.” Therefore, the header contains the previous payment information for the music program to be transmitted to the user, which means the user has already been charged for the program before it is recorded at the consumer site. This

is also opposed to charging the consumer “upon a recording by the consumer of the music selection on a storage medium located at a consumer,” as appears in claim 40. Thus, for the reasons above and others, Applicants submit that all the limitations of rejected claim 40 are not taught or suggested by Schulhof et al.

Claims 41-42, 48, 52-54, 60, 62, and 64-71 either depend directly or indirectly from claim 40 or were rejected under the same rationale. Thus, Applicants submit that all the limitations of these claims are not taught or suggested by Schulhof et al. for at least the same reasons presented above. Therefore, Applicants submit that claims 40-42, 48, 52-54, 60, 62, and 64-71 of the application are in condition for allowance.

#### ***Rejections under 35 USC § 103(a)***

Claims 43, 55, 44, and 56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schulhof et al. (U.S. 5,572,442), in view of McMillet et al. (U.S. 5,483,535).

Claims 43, 55, 44, and 56 either depend directly or indirectly from claim 40. Thus, Applicants submit that all the limitations of these claims are not taught or suggested by Schulhof et al., any of the other references cited by the Office Action, or any combination thereof, for at least the same reasons presented above.

Therefore, since all the limitations of claims 40-72 are not taught or suggested by the individual references cited in the rejections by the Office Action, or any combination thereof, for at least the reasons presented above, withdrawal of the rejections is earnestly solicited.

#### **CONCLUSION**

Applicants believe that the remarks above are responsive to each point raised by the Examiner in the Office Action and Applicants submit that claims 40-72 of the application are in condition for allowance. Should the Examiner have any questions, comments, or suggestions that would expedite the prosecution of the present case to allowance, Applicants' undersigned representative would very much appreciate a telephone conference to discuss these issues.